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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,612	02/24/2004	Yuping Qiu	QA0283 NP	2956

23914 7590 07/03/2007  
LOUIS J. WILLE  
BRISTOL-MYERS SQUIBB COMPANY  
PATENT DEPARTMENT  
P O BOX 4000  
PRINCETON, NJ 08543-4000

EXAMINER
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LEESER, ERICH A

ART UNIT	PAPER NUMBER
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1624

MAIL DATE	DELIVERY MODE
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07/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/785,612

Applicant(s)

QIU ET AL.

Examiner

Erich A. Leeser

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 17-19 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-11 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 16 is/are rejected.
- 7) ☒ Claim(s) 6-7 and 12-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In correspondence dated April 19, 2007, Applicant amended the instant claims to remove the terms "solvates" and "prodrug" therefrom. As such, Examiner withdraws his previous claim rejections under the first and second paragraph of 35 U.S.C. § 112. Claims 1-16 are pending and under examination.

#### ***Claim Rejections - 35 U.S.C. § 103***

2. Examiner previously rejected claims 1-5 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ikesu et al., U.S. Patent No. 5,306,610. Applicant amended claim 1 such that R<sup>1</sup> cannot be hydrogen arguing that such an amendment effectively avoids the reference. While such an amendment overcomes the second to last chemical core structure disclosed in column 5 of the reference, it does not overcome the last chemical core structure disclosed in column 5 of the reference because the specification defines R as alkyl, alkenyl, cycloalkyl and aryl, just like R<sup>1</sup> of instant claim 1.

Because Examiner does not find Applicant's argument persuasive, his previous rejection of claims claims 1-5 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ikesu et al., U.S. Patent No. 5,306,610 is maintained for the reasons of record.

#### ***Claim Objections***

3. Claims 6-7 and 12-15 are objected to as being dependent upon rejected independent claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

*Allowable Subject Matter*

4. Claims 8-11 are patentable over Ikesu et al., U.S. Patent No. 5,306,610. The reference teaches photographic couplers comprising compounds which have an analogous core structure to the compounds of the instant application. The difference between the compounds of the reference and the compounds of claims 8-11 is that the reference teaches compounds which have a heterocyclic ring at position R<sup>1</sup> whereas the compounds of claims 8-11 have a substituted phenyl ring at corresponding position R<sup>6</sup> of formula (I). Therefore, the claims are not taught or fairly suggested by the prior art of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

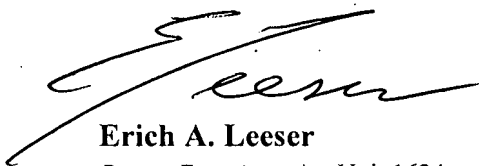
Art Unit: 1624

***Conclusion***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

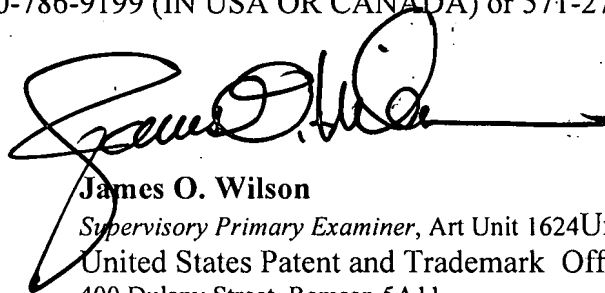
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Erich A. Leeser**

Patent Examiner, Art Unit 1624  
Patent and Trademark Office  
400 Dulany Street, Remsen 5C11  
Alexandria, VA 22314-5774  
Tel. No.: (571) 272-9932



**James O. Wilson**

Supervisory Primary Examiner, Art Unit 1624 United States  
United States Patent and Trademark Office  
400 Dulany Street, Remsen 5A11  
Alexandria, VA 22314-5774  
Tel. No.: (571) 272-0661